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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,679	03/30/2000	Greg Linden	249768021US	8745

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/538,679

Applicant(s)
Linden6

Examiner
Steven McAllister

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3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 30, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the claims are similar. This is not found persuasive because additional search and consideration would be required for the additional groups. For instance, claim 41 requires search for the logical grouping of the functions of the system.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 37-41, 54 and 55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Claim Objections

3. Claim 1 is objected to as based on a disclosure which is not enabling. Assuming that "same" is being given its established meaning of "identical", that the description of the distinguished item and description of the item identified as the same auction fully describe every relevant aspect of their products is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Since the method is being called upon to identify an auction for the

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same item, all aspects of the item must be described. For instance, any description of a bolt might need at least diameter, length, thread, head type, material, coating, etc. If descriptions contained a subset of these aspects, even an apparent perfect correspondence might show dissimilar bolts, for instance bolts with dissimilar lengths or bolts with different thread types.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "identifying as an auction offering an item that is the same as the first item". Assuming that the claim relies on the established definition of "same" meaning identical, the claim method cannot identify that the item is the same as the one identified. Rather it can only identify an item having a description where the sum of the inverse document frequencies of the selected terms exceeds a threshold. It can only predict similarity based on keywords.

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6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Alternatively, assuming that "same" is not meant to mean identical as discussed above, the term "same" in claim 1 is used by the claim to mean "similar or the same," while the accepted meaning is "resembling in every relevant respect; conforming in every respect; being one without addition, change, or discontinuance: identical."

Claim 16 recites displaying "all of the identified purchasing opportunities whose purchasing opportunity scores each exceed the minimum threshold". Claim 16 depends from claim 14 which recites displaying "a proper subset of the identified purchasing opportunities whose opportunity scores each exceed a minimum threshold". Since claim 16 recites displaying all opportunities, it appears that it cannot logically depend from claim 14. In examining the claims, it was assumed that claim 16 depends from claim 2.

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Philips Semiconductors webpage in view of Ishikawa et al (5,848,407) and Sato et al (6,212,517).

Assuming that same means essentially “the same or similar” as argued by the Applicant, Philips shows displaying information about a first sale item including a description; receiving user input requesting user input for similar items comprising receiving input from the “Find Similar Items” button or receiving input from one of the links listed below the “Find Similar Items” heading; and displaying information about the identified similar items. Philips does not show a method for determining similar items. Sato et al show determining for the specified text, the IDF of terms occurring in the text and selecting a plurality of search terms having the largest IDFs and searching the selected keywords. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by performing the steps of Sato et al in order to provide a search tool which provides a measure of item similarity without requiring additional customer input. Philips further does not show determining which of the terms is in the found item’s description and identifying a similar auction where the sum of the IDFs determine the similarity. Ishikawa et

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al show these steps. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by determining similar documents by adding the IDF's for the terms in order to provide a simple and efficient means of determining similarity. Finally, Philips does not show sales of items via auction. However, it is notoriously old and well known in the art to sell items via online auction. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by auctioning items in order to get the highest price.

As to claim 2, Philips shows a purchasing opportunity at a store displaying information about a first sale item including a description. Philips does not show the specific search method. Sato et al show determining for the specified text, the IDF of terms occurring in the text and selecting a plurality of search terms having the largest IDF's. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by performing the steps of Sato et al in order to provide a search tool which provides a measure of item similarity without requiring additional customer input. Philips further does not show performing the search or establishing a score based on summing the term scores of the key words. Ishikawa et al show these steps. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by finding and scoring similar documents by adding the IDF's for the terms in order to provide a simple and efficient means of determining similarity

As to claim 7, it is noted that Philips shows selecting the purchasing opportunities in response to a request from the user.

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As to claims 8-10, it is noted that claimed subject matter is obvious over the claimed step of claim 7. Alternatively, if it were determined that the claims were patentably distinct over claim 7, a species requirement would be necessary.

As to claim 11, it is noted that Philips in view of Sato et al and Ishikawa et al show displaying the purchasing opportunity with the highest score.

As to claim 12, Philips in view of Sato et al and Ishikawa et al show all elements of the claim except showing the similar purchasing opportunity in response to a request for information about the distinguished purchasing opportunity. However, it is notoriously old and well known in the art to show a similar item along with the item requested. It would have been obvious to one of ordinary skill in the art to do so in order to present more purchasing opportunities to the buyer and therefore increase the chances of his making a purchase.

As to claim 13, all elements of the claim are shown except listing the purchasing opportunities in order of their scores. However, it is notoriously old and well known in the art to list search results in descending order of relevance or similarity. It would have been obvious to one of ordinary skill in the art to further modify the method of Philips by doing so in order to present the most likely purchase opportunities first.

As to claim 16, it is noted that Philips in view of Sato et al and Ishikawa et al show displaying a subset containing all opportunities exceeding a minimum threshold.

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As to claims 14 and 15, it is noted that claimed subject matter is obvious over the claimed step of claim 16. Alternatively, if it were determined that the claims were patentably distinct over claim 16, a species requirement would be necessary.

As to claim 17, it is noted that Sato et al show selecting a fixed number of keywords.

As to claims 18 and 19, it is noted that claimed subject matter is obvious over the claimed step of claim 17. Alternatively, if it were determined that the claims were patentably distinct over claim 17, a species requirement would be necessary.

As to claims 20-22, 24, and 26, it is noted that Philips shows these description elements.

Additionally, it is noted that it is old and well known in the art to include any of the elements of claims 20-36 as appropriate for the type of sale and kind of items being sold. It would have been obvious to one of ordinary skill in the art to modify the method of Philips by including such information in order to facilitate ease of purchase.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052.


Steven B. McAllister

September 8, 2003